

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

The Examiner has invited Applicant to submit a copy of the European Search Report cited in the form PTO-1449 which was originally filed on March 3, 2004. Attached is a copy of the European Search Report, together with an Examiner-initialed form PTO-1449 citing such document. Consideration of the European Search Report and issuance of an Examiner-initialed form PTO-1449 is respectfully requested.

Applicant notes with appreciation the indication that claims 28 and 29 are allowed, and that claims 26 and 27 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims (Official Action at page 4).

By the above amendments, the specification at pages 6 and 8 has been amended in accordance with the Examiner's suggestion to recite that in general formulas (2) and (4), Z² represents a polymethine chain of at least 5 carbon atoms.

In the Official Action, claims 24 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Document No. 2000-289341 (*JP '341*). Without addressing the propriety of the Examiner's comments concerning the subject matter disclosed by *JP '341*, it is respectfully noted that *JP '341* does not constitute §102(a) or (b) prior art. In this regard, the present application claims the benefit of priority of Japanese Patent Application No. 2000-169180 filed June 6, 2000. The June 6, 2000 filing date of the foreign priority application predates the October 17, 2000 publication date of *JP '341*. The foreign priority claim in the present application was perfected by the previous submission of a verified English translation of the foreign priority application on November 23, 2004.

For at least the reasons discussed above, withdrawal of the rejection based on *JP '341* is respectfully requested.

Claim 24 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,555,481 (*Ukai et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 24 is directed to an infrared absorber comprising, in a molecule thereof, a fluorine-containing substituent which has at least 5 fluorine atoms.

Ukai et al relates to silver halide photographic emulsions in which spectral sensitivity of the green wavelength range is particularly increased (col. 1, lines 11-14).

Ukai et al does not disclose each feature recited in claim 24, and as such fails to constitute an anticipation of such claim. For example, *Ukai et al* does not disclose an infrared absorber comprising, in a molecule thereof, a fluorine-containing substituent which has at least 5 fluorine atoms, as recited in claim 24. In this regard, the Patent Office has taken the position that the compounds represented by formulas (I) and (II) of *Ukai et al* "are inherently infrared absorbing because of the structural similarities to other infrared absorbing cyanine dyes" (Official Action at page 4) (emphasis added). However, the Patent Office has not established with the requisite certainty, that *Ukai et al* inherently discloses that the formula (I) and (II) compounds are infrared absorbers as presently claimed.

The Patent Office's burden of proof for properly alleging an inherent disclosure is well established. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949,

1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent feature necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the present case, the Patent Office has not provided any evidence or scientific reasoning which establishes that the formula (I) and (II) compounds disclosed by *Ukai et al* are infrared absorbers as is presently claimed. As mentioned above, the Patent Office has asserted that the cyanine dyes of *Ukai et al* have structural similarities to other infrared absorbing cyanine dyes.¹ However, the Patent Office has not identified the "other infrared absorbing cyanine dyes", nor provided any comparison between the structures of the formula (I) and (II) compounds disclosed by *Ukai et al* and such other infrared absorbing cyanine dyes. For at least this reason, it is respectfully submitted that the Patent Office has failed to meet its burden of proof for establishing inherency of the above claimed feature.

Moreover, attached hereto for the Examiner's consideration is a copy of U.S. Patent No. 2,945,763, which discloses a dye compound at column 2 thereof, that is similar in structure to the formula (I) and (II) compounds disclosed by *Ukai et al*. For example, the dye compound of the '763 patent and the *Ukai et al* compounds both have similar fused-ring structures, as well as $-\text{CH}=\text{CH}-\text{CH}=$ groups located between the fused rings. As can be seen from Fig. 1 of the '763 patent, the dye compound exhibits an absorption peak at about 600 to 610 nm, which shows that the dye compound is not an infrared absorber. Thus, in light of the

¹ It is noted that the exemplary general formula (I) compound recited in claim 25 of the present application, has a structure that is different from the formula (I) and (II) compounds disclosed by *Ukai et al*. For example, whereas Z^1 in the claimed general formula (I) compound represents a heptamethine group, the compounds disclosed by *Ukai et al* have a $-\text{CH}=\text{CH}-\text{CH}=$ group in the position corresponding to Z^1 .

structural similarities between the dye compound disclosed by the '763 patent and the *Ukai et al* compounds, it is far from certain that the *Ukai et al* compounds are infrared absorbers.

For at least the above reasons, it is apparent that *Ukai et al* does not constitute an anticipation of claim 24. Accordingly, withdrawal of the above §102(b) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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